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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

HAMPTON HIGHTOWER, PATRICIA

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1711 | 8 |

DATE MAILED: 03/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,183

Applicant(s)

BIGG ET AL.

Examiner

Patricia Hightower

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 26 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-7, 9-80, 82-99, 101-127, 129-157 and 159-168 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 12, 17-19, 38-44, 51, 75-80, 82, 83, 86-99, 106-116, 125, 129, 130, 133-142 and 153-155 is/are rejected.
- 7) ☒ Claim(s) See Continuation Sheet is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims objected to are 4-7,9-11,13-16,20-37,45-50,52-74,84,85,101-105,117-124,126,127,131,132,144-152,156,157 and 159-168.

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Response to Amendment

The amendment filed November 26, 2002 in which claims 8, 81, 100, 128 and 158 were canceled is acknowledged; claims 1-7, 9-80, 82-99, 101-127, 129-157 and 159-168 are presently pending. In view of the applicants' response filed November 26, 2002 the rejection of claims 1-5 as anticipated by Imashiro et al (USP 5,973,024) has been withdrawn.

However, claims 1-3, 12, 17-19, 38-44, 51, 75-80, 82-83, 86-99, 106-116, 125, 129-130, 133-142 and 153-155 are subject to a new ground of rejection under 35 USC 102(b) as anticipated by Hammel et al (USP 5,134,171) newly cited.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 12, 17-19, 38-44, 51, 75-80, 82-83, 86-99, 106-116, 125, 129-130, 133-142 and 153-155 are newly rejected under 35 U.S.C. 102(b) as being anticipated by Hammel et al (USP 5,134,171 newly cited).

Hammel et al (USP 5,134,171 newly cited) discloses degradable foam materials prepared of or from polyhydroxy acid resin compositions which are foamed with environmentally benign compositions, that are degradable and cause minimal

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environmental impact which anticipates the claimed invention. See abstract; col. 2, lines 45-68; col. 3, lines 1-et.seq.; col. 4, lines 8-55, 65-67; col. 6, lines 3-12, 19-26; the claims.

Hammel et al teaches *at col. 4, lines 40-55 that the term degradable as used here with respect to the polylactate polymer means the polylactate portion of the degradable material is biodegradable and degrades by hydrolysis. **The degradation rate is consistent with its intended use; i.e., the product does not significantly degrade in normal storage and usage, but will degrade significantly in a reasonable time after discarding. As is known in the art, hydrolysis degradation is dependent on the degree of crystallinity of the polymer; the higher crystallinity polymers degrade more slowly. For hydrolysis degradation slightly acidic or basic conditions may be used advantageously. **By hydrolysis degradation monomer units can be recovered if desired for reconversion to useful polylactate polymers or can be discarded as an environmentally benign waste material.*****

The patentee teaches further *at col. 6, lines 3-12 the foam products have a unique combination of properties making them environmentally acceptable both with respect to the atmosphere and also for disposal. They can be landfilled whereupon they will biodegrade and/or hydrolyze to harmless degradation products or can be recycled by hydrolysis depolymerization.*

Applicant's arguments with respect to claims 1-7, 9-80, 82-99, 101-127, 129-157 and 159-168 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

Claims 4-7, 9-11, 13-16, 20-37, 45-50, 52-74, 84-85, 101-105, 117-124, 126-127, 131-132, 144-152, 156-157 and 159-168 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. These references are cited to show the state of the art of biodegradable polymers; Gruber, Sinclair, Verhelst, Downie, Garcia and Goldberg.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia Hightower whose telephone number is (703) 308-2434. The examiner can normally be reached on Monday – Friday from 9:30 a.m. - 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



P. Hightower:mn
March 20, 2003

P. Hampton-Hightower
Primary Examiner
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